

10/676,706

DOCKET NO.: P1845RIC2

REMARKS

At the time of the 04/14/04 Office Action, claims 1-16 were pending in the instant application. Upon cancellation of claims 11-16, amendment of claim 1, and addition of new claim 17, the instant application will have pending claims 1-10 and 17. New claim 17 is fully supported in the specification as filed and does not add new matter.

Restriction Requirement

The Examiner has required restriction of the claims and has provided a non-inclusive grouping of invention as follows:

- I. Claims 1-13 drawn to a compound of formula II;
- II. Claims 14-15 drawn to a method of treating a disease; and
- III. Claim 16 drawn to a method of inhibiting binding to a protein ligand.

Applicants hereby elect with traverse group I directed to compounds of formula II and species of compound 8 found in example 5 (page 39) of the specification.

"If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP 803. Compounds of the invention all have a structural similarity or common core as defined by formula II in that they all incorporate a fluorenyl ring linked to a phenylalanine analog residue and possess a common utility as inhibitors of alpha-4 integrins.

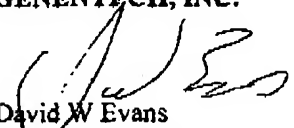
Applicants herein amend the definition of substituent designated R9 such that the claims do not encompass compounds claimed in parent application that has issued as US patent no. 6,706,753. The instant claims are otherwise commensurate in scope to the '753 patent and are likewise believed not to present an undue burden to search or examine.

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Respectfully submitted,

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* A copy of a document pursuant to 37 C.F.R. §101.9(b) is attached as proof of the authorization of the above to prosecute the attached application. The original of this document is on file in the Office of enrollment and Discipline.

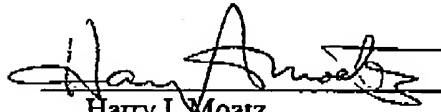
**BEFORE THE OFFICE OF ENROLLMENT AND DISCIPLINE
UNITED STATES PATENT AND TRADEMARK OFFICE**

LIMITED RECOGNITION UNDER 37 CFR § 10.9(b)

David Evans is hereby given limited recognition under 37 CFR § 10.9(b) as an employee of Genentech, Inc. to prepare and prosecute patent applications in which Genentech, Inc. is the assignee of record of the entire interest. This limited recognition shall expire on the date appearing below, or when whichever of the following events first occurs prior to the date appearing below: (i) David Evans ceases to lawfully reside in the United States, (ii) David Evans' employment with Genentech, Inc. ceases or is terminated, or (iii) David Evans ceases to remain or reside in the United States on an H1B1 visa.

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Expires: April 6, 2005



Harry I. Moatz
Director of Enrollment and Discipline